



1248-R-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Adrienne Lewis

Examiner: James W. Myhre

Serial No.: 09/981,156

Group Art Unit: 3622

Filed: October 17, 2001

For: SYSTEM AND METHOD OF ADVERTISING ON A COMPUTER NETWORK

DECLARATION OF STEEN KANTER UNDER 37 CFR § 1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, STEEN KANTER, hereby declare as follows:

1. I am the founder and Chief Executive Officer of Kanter International, a business and brand development firm. The firm is in the business of building leading brand names, including concept and business model development, organizational planning, executive management development, positioning & marketing strategy, sales training and business development, advertising and interactive services.
2. I have thirty three years of experience as an executive with companies that represent leading international consumer brands.
3. I worked for IKEA for twenty-two years building their brand in five countries. During this time I served as President of IKEA U.S. East and was a member of IKEA's North American Board of Directors.
4. Prior to founding Kanter International, I was the Vice Chairman and CEO of Lechters Housewares and the President and CEO of the Body Shop, U.S., a UK-based cosmetic manufacturer and retailer with more than 1,500 franchised and company-owned stores in 46 countries.
5. Since 1998, I have provided consulting services to entrepreneurs and emerging companies to build brand name recognition using a customer-oriented approach, including advertising on the Internet. I believe I have in depth knowledge of and at least routine skill in the field of advertising on the Internet.
6. I am familiar with the invention described in U.S. Patent Application No. 09/981,156. I have reviewed the Patent Application and an Amendment to the claims in the patent

application, which I understand is being submitted to the Patent Office concurrently with this declaration.


7. FabGORGON (now an integrated part of Kanter International) assisted the inventor, Adrienne Lewis, and her company, adTraction, by writing software code that utilizes the steps claimed in the patent application (as amended by the present amendment). I have first hand knowledge of the development and functionality of the software.
8. The software developed by fabGORGON was written for trial use on the Tommy Hilfiger website, www.tommy.com, pursuant to an agreement between adTraction and Tommy Hilfiger. The software is for an interactive game of Concentration (hereinafter the "adTraction Concentration game") that could be played by visitors to the website.
9. The game included a panel of eighteen (18) boxes or cards bearing the Tommy Hilfiger logo. When a website visitor clicked on a box, the card would flip and reveal an advertising image of a model wearing Tommy Hilfiger clothing. As in the classic game Concentration, the purpose of the adTraction Concentration game was to remember where an image was located within the panel and match up the image with a second corresponding image somewhere else within the panel.
10. The adTraction Concentration game was on the Tommy Hilfiger website for a test period of approximately three (3) months. During this three-month period, the game was played by website visitors approximately 87,000 times.
11. Prior to playing the adTraction Concentration game, each new visitor was required to sign up as a member of "Club Tommy" and provide personal information, which could then be used for marketing purposes.
12. The adTraction Concentration game provided Tommy Hilfiger with many new website visits, as well as valuable marketing information. Based on any reasonable standard, the three-month trial period of the adTraction Concentration game on the website was a complete success. It is my understanding that Tommy Hilfiger was extremely pleased with the success of the adTraction Concentration game.
13. Following the three-month trial period, Tommy Hilfiger terminated relations with adTraction and removed the adTraction Concentration game from the website.
14. Subsequent to the removal of the adTraction Concentration game from the Hilfiger website, another concentration game, which was substantially similar to the adTraction concentration game, appeared on the Tommy Hilfiger website. It is believed that Tommy Hilfiger's website designer, Organic, Inc., copied the adTraction Concentration game in creating the new concentration game (hereinafter the "Organic Concentration game").
15. I have played the Organic Concentration game. The screen displays, animation and functionality of the Organic Concentration game are substantially similar to those of the adTraction Concentration game. The Organic Concentration game appeared to perform all of the steps claimed in the patent application.

16. Following the discovery of the Organic Concentration game on the Tommy Hilfiger website, adTraction filed a lawsuit for, among other things, copyright infringement against Hilfiger. As a result of the lawsuit, Tommy Hilfiger removed the infringing Organic Concentration game from the website.
17. Prior to entering into the agreement with adTraction, several executives of Tommy Hilfiger were extremely skeptical that the adTraction Concentration game would be commercially successful.
18. As evidenced by the game's actual commercial success and by Tommy Hilfiger's copying of the game after expiration of the trial period, the skepticism expressed by the executives has been proven unfounded.
19. In my opinion, the present invention solved a long-felt need in the area of Internet advertising. Specifically, it has been known by those in the field that conventional Internet advertising methods, in the form of banners or pop-up windows, are often viewed by Internet users as nuisances. By incorporating the advertising images as active game elements that the player must use, the invention transforms the advertising images into a welcome and accepted part of an Internet website. The invention can further increase user enjoyment by tailoring advertising images in an interactive game to the interests of individual players.
20. It is my belief that the invention represents a new, unique and very successful method of advertising on the Internet. The invention has not only solved the long-felt need of finding a way to make advertising acceptable to Internet users, but also encourages users to interact with and enjoy the advertising images. The invention has enjoyed actual commercial success on the Tommy Hilfiger website, and this commercial success led to the copying of the invention by Hilfiger in the form of the Organic Concentration game.
21. I have reviewed U.S. Patent No. 5,916,024 to Von Kohorn and the Office Action of May 7, 2004, which compares Von Kohorn to the present invention.
22. Von Kohorn does not describe the use of advertising images as active game elements, as claimed in the present application. Instead, Von Kohorn describes a game in which images of products are broadcast to players and then questions are asked about those products. The players do not use the broadcast images or any other advertising image as active game elements. Instead, the player merely enters his or her responses to the questions on a keyboard or other device that does not include the advertising image. Therefore, it is my opinion that a fair reading of Von Kohorn does not disclose or suggest the use of advertising images as active game elements, as is claimed in the present application.
23. Von Kohorn also does not describe or suggest the steps of collecting demographic information and using that information to tailor advertising content to individual players. The passage of Von Kohorn in column 137, lines 40-67, describes a method of polling players. The passage indicates that data gathered by the polling is used to disqualify

respondents from playing the game and can be made available to the sponsor for subsequent marketing. The bottom of column 137 indicates that the software designed in connection with the polling allows for the flexibility of individually programming circuitry to achieve stated objectives. A fair reading of this passage, in combination with Von Kohorn as a whole, suggests that the polling software is flexible and can be modified to suit the needs of the game operator. In my view, there is no suggestion in this passage or anywhere else in Von Kohorn that the polling data be used to tailor advertising content to the individual player based on his or her responses to the polling questions.

24. The various passages cited in the Office Action of May 7, 2004 to allegedly show each element of the invention are taken from several places throughout Von Kohorn. The passages relate to various distinct embodiments described in the reference. Therefore, even assuming for the sake of argument that Von Kohorn described all of the elements of the invention, a fair reading of the entire description of Von Kohorn would not teach or suggest the combination of the elements into a single implementation of a game as suggested in the Office Action.
25. Therefore, it is my opinion that the invention represents a new, unique and non-obvious approach to Internet advertising over that described in Von Kohorn. In addition, based on my knowledge of the field, I believe the invention represents a new and non-obvious advancement in Internet advertising in general.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


STEVEN KANTER

9/11/04
Date


Witness

9/11/2014
Date

Notary Public
North Carolina
I hereby certify that Steven Kanter
personally appeared before me this day and
acknowledged the due execution of the
 foregoing instrument.
Witness my hand and official seal, this 11th
day of Sept, 20 14.
Notary Public
Commission Expires 1-14-2009.